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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,156	10/19/1998	KEITH LYNN PUTNAM	98.P.7912.US	6575

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SIEMENS CORPORATION
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EXAMINER

ESCALANTE, OVIDIO

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/175,156

Applicant(s)

PUTNAM ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on December 7, 2005. **Claims 1-27** are now pending in the present application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16, 19 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Bremer US Patent 6,018,671.

Regarding claim 16, Bremer teaches a method for presenting an audio message to a telephone caller, (abstract; fig. 4), comprising:

detecting, at the recipient telephone, ringing signaling an incoming telephone call, (col. 1, lines 10-16; col. 3, lines 7-11; col. 5, lines 25-35);

generating, from the recipient telephone, a user alert in response to the incoming telephone call, based on the incoming phone call itself, (col. 3, lines 9-11; col. 5, lines 25-35);

receiving a command from a called party in response to the user alert, (col. 3, line 61-col. 4, line 21);

generating from the recipient telephone an audio message based on the command, (col. 4, lines 13-21);

answering the incoming call, (fig. 4; col. 4, lines 13-21); and

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playing the audio message to the telephone caller over the telephone network, (col. 4, lines 13-21).

Regarding claim 19, Bremer, as applied to claim 16, teaches manually entering the command using a keypad, (col. 4, lines 13-21).

Regarding claim 22, Bremer, as applied to claim 10, teaches wherein the ring detector is configured to detect the incoming phone call based on the incoming phone call itself, (col. 3, lines 7-11; fig. 4).

Regarding claim 23, Bremer, as applied to claim 22, teaches wherein the ring detector is configured to detect a ring signal of the incoming telephone call, (col. 3, lines 7-11; col. 5, lines 25-35).

Regarding claim 24, Bremer, as applied to claim 16, teaches wherein the detecting step detects the incoming telephone call by detecting a ring signal of the incoming telephone call, (col. 3, lines 7-11; col. 5, lines 25-35).

4. Claims 10 and 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Milewski US Patent 6,519,326.

Regarding claim 10, Milewski teaches a telephony device for playing a customized message to a caller, (abstract; col. 4, lines 38-51), comprising:

a ring detector generating a detection signal in response to an incoming telephone call, (col. 3, lines 47-55; col. 5, lines 24-34);

a ringer alerting a called party to the incoming call in response to the detection signal, (col. 3, lines 47-55; col. 5, lines 24-34);

a command interface for receiving one or more message parameters from the called party, (col. 4, lines 28-34,38-51); and

a controller for activating the command interface in response to the detection signal and for transferring the customized message to the caller, wherein the controller is an element of the telephone, the customized message being transferred from the telephony device via the telephone network (col. 4, lines 52-59) wherein the controller is configured to record the customized message while the incoming call is pending, (col. 4, lines 28-34,38-51);

wherein the telephony device can responds to the incoming call by answering the call, transferring the customized message and releasing the call or can accept the call by going off hook, (col. 4, lines 1-7,28-34).

Regarding claim 12, Milewski, as applied to claim 10, teaches an audio interface for receiving a spoken message from the called party, (col. 4, lines 38-51; the audio interface receives e.g. “Hi Bob, I only have a minute to talk”).

Regarding claim 13, Milewski, as applied to claim 12, teaches a memory for storing the spoken message, (co. 4, lines 28-34,38-51).

Regarding claim 14, Milewski, as applied to claim 10, teaches a keypad permitting the called party to manually enter the message parameters, (fig. 2).

Regarding claim 15, Milewski, as applied to claim 10, teaches a caller identification unit for displaying caller information to the called party, (fig. 2).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-4,7-9,20,21 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer in view of Adams US Patent 6,400,814.

Regarding claim 1, Bremer teaches a system for responding to an incoming phone call from a calling party, (abstract; fig. 4), comprising:

means for receiving the incoming phone call, (col. 3, lines 7-9; fig. 1);

means for generating a user alert in response to the incoming phone call, (col. 3, lines 9-11);

means at a called party's telephone for enabling selective entry of a user message entered in response to the alert while the incoming call is pending, (fig. 4; col. 3, line 61-col. 4, line 21); and

means for playing the user message to the calling party, said playing means including means for transmitting said user message from the called party telephone to the calling party telephone via the telephone network, (col. 4, lines 13-21).

While Bremer teaches that the incoming call is pending while the user is selecting the user message, Bremer does not specifically teach entering the message while the incoming call is pending and still ringing to the calling party.

In the same field of endeavor, Adams teaches means for enabling selective entry of a user message entered in response to an alert while the incoming call is pending and still ringing to the calling party, (col. 6, lines 14-60; call continues to ring until after the user sends a user message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bremer by allowing the incoming call to remain ringing as taught by Adams so that the central office can route the incoming call to another destination if the called party selects a command to send the user to another destination. By having the call still ringing and thus unanswered then one of several routing destinations can be selected.

Regarding claim 2, Bremer, as applied to claim 1, teaches means for releasing the call after playing the message, (fig. 4; col. 4, lines 52-65).

Regarding claim 3, Bremer, as applied to claim 1, teaches means for displaying caller identification information to the user, (col. 3, lines 9-11).

Regarding claim 4, Bremer, as applied to claim 1, teaches wherein the receiving means includes means for activating a user command interface for predetermine period of time following commencement of the user alert, (col. 4, lines 4-13).

Regarding claim 7, Bremer, as applied to claim 1, teaches wherein the receiving means includes means for manually selecting the user message, (col. 4, lines 4-21).

Regarding claim 8, Bremer, as applied to claim 1, teaches wherein the means for receiving includes means for recording an audio user message, (col. 4, lines 30-37).

Regarding claim 9, Bremer, as applied to claim 1, teaches wherein the means for receiving includes means for storing the user message, (col. 4, lines 31-37).

Regarding claim 20, Bremer, as applied to claim 1, teaches wherein the system is incorporated within a telephone, (figs. 1 and 2).

Regarding claim 21, Bremer, as applied to claim 10, does not specifically teach wherein the command interface receives the one or more message parameters from the called party while the incoming call is not yet connected.

In the same field of endeavor, Adams teaches wherein the command interface receives the one or more message parameters from the called party while the incoming call is not yet connected, (col. 6, lines 14-60; call continues to ring until after the user sends a user message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bremer by allowing the incoming call to remain ringing as taught by Adams so that the central office can route the incoming call to another destination if the called party selects a command to send the user to another destination. By having the call still ringing and thus unanswered then one of several routing destinations can be selected.

Regarding claim 25, Bremer, as applied to claim 1, teaches wherein said means for playing the user message to the calling party is configured to cause playing the user message to the calling party in some instances in which the user refuses to answer the incoming phone call, (fig. 4; col. 4, lines 3-21).

Regarding claim 26, Bremer as applied to claim 1, teaches wherein the means for generating a user alert in response to the incoming phone call comprises means for detecting the incoming phone call based on the incoming phone call itself, (figs. 1 and 4; col. 3, lines 7-39).

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Regarding claim 27, Bremer, as applied to claim 26, teaches wherein the means for detecting the incoming phone call comprises means for detecting a ring signal of the incoming telephone call, (fig. 4; col. 3, lines 7-39; col. 5, lines 25-35).

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer in view of Adams and further in view of Wolff US Patent 5,327,486.

Regarding claims 5 and 6, Bremer and Adams, as applied to claim 1, does not specifically teach wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command and wherein the at least one spoken command includes a predetermined instruction and a variable parameter.

In the same field of endeavor, Wolff teaches that it was well known in the art to have receiving means which includes a voice recognition unit for recognizing at least one spoken command that include message parameters (col. 7, lines 17-22) and

wherein the at least one spoken command includes a predetermined instruction (verbal command) and a variable parameter, (col. 6, lines 17-36., col. 7, lines 5-22., figs. 8 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bremer by using speech recognition as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Wolff US Patent 5,327,486.

Regarding claims 11-13, Milewski, as applied to claim 1, does not specifically teach wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command and wherein the at least one spoken command includes a predetermined instruction and a variable parameter.

In the same field of endeavor, Wolff teaches that it was well known in the art to have receiving means which includes a voice recognition unit for recognizing at least one spoken command that include message parameters (col. 7, lines 17-22) and

wherein the at least one spoken command includes a predetermined instruction (verbal command) and a variable parameter, (col. 6, lines 17-36., col. 7, lines 5-22, . figs. 8 and 9).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Milewski by using speech recognition as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device.

10. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer in view of Wolff US Patent 5,327,486.

Regarding claims 17 and 18, Bremer, as applied to claim 1, does not specifically teach wherein the receiving means includes a voice recognition unit for recognizing at least one spoken command and wherein the at least one spoken command includes a predetermined instruction and a variable parameter.

In the same field of endeavor, Wolff teaches that it was well known in the art to have receiving means which includes a voice recognition unit for recognizing at least one spoken command that include message parameters (col. 7, lines 17-22) and

wherein the at least one spoken command includes a predetermined instruction (verbal command) and a variable parameter, (col. 6, lines 17-36., col. 7, lines 5-22., figs. 8 and 9). Wolf further teaches an audio interface for receiving a spoken message from the called party and a memory for storing the spoken message, (col. 6, lines 17-36., col. 7, lines 5-22., figs. 8 and 9); and recording a spoken message from the called party and including the spoken message in the audio message, (col. 6, lines 17-36., col. 7, lines 5-22., figs. 8 and 9)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bremer by using speech recognition as taught by Wolff so that the user can operate the device in a hands free mode and so that the system can validate the end user through speaker recognition techniques to ensure privacy protection of the device.

Response to Arguments

11. Applicant's arguments with respect to claims 10-15 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed December 07, 2005 have been fully considered but they are not persuasive.

Applicant contends that Bremer does not teach, in regards to claim 16, "generated, from the recipient telephone, an audio message based on the command," and in contrast only teaches

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for a user to select a prerecorded message and does not permit the user to customize a message on the fly. The Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., user to customize a message on the fly) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims merely recite generating an audio message based on the command and does not claim permitting the user to "customize" a message.

The command is inputted by the user in response to a user alert which as stated by Bremer is taught in col. 3, lines 9-11 and col. 5, lines 25-35. The user issues a command in response to a user alert and then an audio message is played to the calling party.

Applicant contends that Adams does not teach "recording a message while a call is pending" or "enabling selective entry of a user message entered in response to the alert while the incoming call is pending and still ring to the calling party." The Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recording a message while a call is pending) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

There is no "recording" feature claimed in claim 1. The claims merely recite enabling selected entry of a user message entered in response to the alert while the incoming call is

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pending and still ringing. Thus, since Adams teaches of a user entering a user message in response to the incoming call as shown in col. 6, lines 14-60, then the claimed limitations are met. A user message can also be broadly interpreted as a user command message, thus any message either by sending a control signal or sending an actual text/spoken message can read on a user message.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any response to this action should be mailed to:

Commissioner for Patents
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Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

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Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
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February 27, 2006

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